

REMARKS

Claims 1-6 are all the claims pending in the application. Claims 3 and 4 are withdrawn from consideration. Claims 5 and 6 are added via this amendment.

ELECTION/RESTRICTION:

Applicants thank the Examiner for acknowledging the election of Group I, claims 1 and 2.

35 U.S.C. § 103:

Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' admitted prior art (AAPA) in view of Marquiss et al. (U.S. Patent No. 6,838,051 [hereinafter "Marquiss"]).

The Examiner applies Applicants' admitted prior art against the majority of claimed features and relies on Marquiss for allegedly teaching a light monitor that is a correction means. Marquiss does not teach at least the claimed correction means. In particular, claim 1 is drawn to a novel combination of elements that provides a nonobvious incubator. Prior art incubators have suffered from the inability to accurately monitor a distance between a dry analysis element and a light measuring head. Various attempts have been made to address this problem, as discussed in the present specification.

Marquiss is directed to an integrated sample-processing device including components for preparing and analyzing samples. Marquiss discloses an intricate system having many parts as shown in Figures 1-57. The Examiner cites element 5122 against the claimed correction means. Applicants respectfully submit that even if, *arguendo*, one was motivated to combine the art,

each feature of claim 1 would not be taught or suggested. Element 5122 is shown in Figure 52 of Marquiss and is described as being a light monitor. In particular, Marquiss discloses that:

“Light monitor 5122 is used to correct for fluctuations in the intensity of light provided by the light sources. Such corrections may be performed by reporting detected intensities as a ratio over corresponding times of the luminescence intensity measured by the detector to the excitation light intensity measured by the light monitor. The light monitor also can be programmed to alert the user if the light source fails.” (Emphasis added.)

See col. 41, lines 40-48 of Marquiss.

This does not teach or suggest the correction means of claim 1, as would be appreciated by one skilled in the art. For example, claim 1 recites, *inter alia*:

“the light measuring means is provided with a correction means which compensates for fluctuation in the value of the optical density of the dry analysis element in each of the element chambers as measured by the light measuring head generated due to fluctuation in the distance between the light measuring head and the element chamber on the basis of a correction value which has been stored in the correction means, element chamber by element chamber.” (Emphasis added.)

The claimed correction means compensates for fluctuation in a value of an optical density of the dry analysis element. The light monitor 5122 of Marquiss does not compensate for a fluctuation in value of the optical density of a “dry analysis element”. Instead, the light monitor 5122 of Marquiss is used to correct a fluctuation in light intensity of the “light source.” That is, the light monitor acknowledges if the light source is not proper. However, there is no compensation provided by the light monitor 5122 for the value of the optical density of any dry analysis element.

Furthermore, claim 1 describes that compensation is provided due to “fluctuation in the distance between the light measuring head and the element chamber.” Marquiss does not

provide compensation due to a distance between a light measuring head (e.g., element 5144 of Marquiss) and an element chamber (e.g., sample holding device 5126 of Marquiss). The distance between the light detector 5144 and the sample holding device 5126 is not even taken into consideration by Marquiss and therefore further supports the lack of teaching in Marquiss.

Moreover, claim 1 recites that the correction means compensates on the “basis of a correction value which has been stored.” The alleged correction means (i.e., light monitor 5122 of Marquiss) does not include any stored correction value, nor would one have been taught or suggested this aspect by the disclosure of Marquiss.

In conclusion, the combined features of claim 1 provide an improved incubator including, *inter alia*, a light measuring means and a correction means, which are neither taught nor suggested by the applied art. Instead, as disclosed in Marquiss, the light monitor 5122 is used to correct fluctuations in an intensity of light provided by a light source and can also be programmed to alert a user if a light source fails. This alone does not teach or suggest the specific features recited in claim 1.

Therefore, the combination of the AAPA and Marquiss does not teach or suggest each feature of claim 1, such that the rejection thereof under 35 U.S.C. § 103(a) should be withdrawn. The rejection of claim 2 should likewise be withdrawn at least by virtue of this claim depending upon claim 1.

With further regard to claim 2, the Examiner contends that its features are directed to a manner in which the device operates and are not considered by the Examiner. Applicants point out that all of the claimed features must be considered in evaluating the patentability of a claim. See MPEP 2173.05(g). Also, an identical invention must be shown in as complete detail as is

contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 2 is, thus, patentable over the applied references by virtue of its dependency and because of its novel recitations. In particular, Marquiss does not disclose the features of claim 2 regarding the correction means. To further emphasize that the features of claim 2 are an integral part of the correction means, claim 2 is amended to describe that the correction means "is operable to set the correction value."

NEW CLAIMS:

New claims 5 and 6 are added to obtain more varied protection and are readable on the elected invention. These claims are patentable over the applied references by virtue of their dependency on claim 1, in addition to their individual recitations.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
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